

## REMARKS

The Office Action dated September 8, 2006 has been received and its contents carefully considered. In the Office Action, claims 6-10 were rejected under 35 U.S.C. § 103(a) as being anticipated by *Omata et al.* (US 6,442,356 B2) and *Sasamoto et al.* (US 6,324,374 B1) in view of *Faré* (US 5,768,653 A). By this reply, claims 6, and 8-10 have been amended. Claim 7 has been cancelled. Accordingly, claims 1-6 and 8-21 are pending in this application. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Applicant appreciates the courteous efforts of Examiner Vargas to expedite prosecution of this application during the personal interview conducted on December 1, 2006. During the interview, Applicant proposed to make a number of claim amendments and provided a draft Amendment for discussion purposes only. Specifically, Applicant proposed to (1) amend claims 6 and 8-10, and (2) cancel claim 7. In response, the Examiner indicated that the proposed amendment would place the application in condition for allowance. Accordingly, Applicant has made the aforementioned amendments to the claims

Claims 6-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Omata et al.* (US 6,442,356 B2) and *Sasamoto et al.* (US 6,324,374 B1) in view of *Faré* (US 5,768,653 A). *Omata et al.* and *Sasamoto et al.* in view of *Faré*, however, fail to render the claimed invention unpatentable. Each of the claims recites a specific combination of features that distinguishes the invention from the prior art in different

ways. For example, independent claim 6 recites a combination that includes, among other things:

a plurality of transfer units for transferring toner images formed on said plurality of image carriers onto said intermediate transfer body each of which is provided for corresponding to each of said plurality of image carriers . . . a driving unit for driving said intermediate transfer body to rotate at a rotary speed . . . and a control unit for controlling said driving unit to drive said intermediate transfer body under a feed-forward control and a feed-back control, the control unit controlling said driving unit according to correction information, wherein the correction information used for the feed-forward control is different depending upon a kind of image . . . wherein said control unit makes said plurality of transfer units to be selectively operated according to the kind of image and said control unit changes a speed control method for said driving unit according to the kind of image . . . wherein the kind of image includes a full-color, a mono-chrome image, or a uni-color image,

(amended claim 6, II. 4-23). At the very least, the applied references, whether taken alone or in combination, fail to disclose or suggest any of the exemplary features recited in independent claim 6.

The Examiner has failed to establish a *prima facie* case of obviousness for at least four reasons. First, the Examiner has not demonstrated how *Omata et al.*, *Sasamoto et al.*, and *Faré*, whether taken alone or in combination, disclose or suggest each and every feature recited in the claims. See M.P.E.P. § 2143 (7th ed. 1998). Second, the Examiner has not shown the existence of any reasonable probability of success in modifying *Omata et al.*, the base reference, based on the teachings of *Sasamoto et al.* and *Faré*, the secondary references, in a manner that could somehow result in the claimed invention. See *id.* Third, the Examiner has not identified any suggestion or motivation, either in the teachings of the applied references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the

apparatus of *Omata et al.* in a manner that could somehow result in the claimed invention. See *id.* Finally, the Examiner has not explained how his obviousness rationale could be found in the prior art — rather than being a hindsight reconstruction of Applicants' own disclosure. See *id.*

Each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record, as required by the Federal Circuit. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. §§ 102(b) and 103. In this case, however, the Examiner has failed to satisfy his burden of demonstrating how *Omata et al.*, taken alone or in combination with *Sasamoto et al.* and *Faré*, can either anticipate or render obvious each and every one of the limitations present in independent claim 6, as required by the MPEP and Federal Circuit jurisprudence.

*Omata et al.* discusses an image forming apparatus capable of selecting an image forming station for use in an image formation from a plurality of image forming stations. In a case where an image formation does not exist at an image forming station, the apparatus of *Omata et al.* is disclosed to provide an image forming apparatus capable of obtaining a stable transfer characteristic and a satisfactory image independently of environmental conditions such as humidity.

The Examiner asserts that *Omata et al.* discloses an image forming apparatus (Figure 5) having a plurality of image carriers (101a-101d), a plurality of transfer units (105a-105d), a plurality of driving units (170a-170d), and a control unit (180). *Omata et al.* employs the control means (180) to regulate a formation of colors through the transfer of current. For example, in column 8, lines 61-67, *Omata et al.* discloses an example for forming a mono-chrome copy. In this case, a color control is effected by transferring current corresponding to one color, such as the black transfer means 105d, to a value 10  $\mu$ A. The transfer current flowing to additional transfer means for producing other colors (e.g., magenta, cyan, and yellow transfer means 105a through 105c) is held at 0  $\mu$ A. Hence, the control means 180 of *Omata et al.* teaches away from the invention, because the control for generating a particular kind of image is provided by regulating a transfer current as opposed to regulating speed as recited in claim 6.

The Examiner attempts to remedy the deficiencies of *Omata et al.* by turning to *Sasamoto et al.* *Sasamoto et al.* discusses an image forming apparatus capable of regulating a contact of a belt-formed member with opposing members. However, *Sasamoto et al.* fails to disclose or suggest performing speed control as recited in claim 6. Furthermore, the Examiner admits that *Omata et al.* and *Sasamoto et al.* fail to provide any disclosure or suggestion of performing speed control as claimed.

The Examiner attempts further to remedy the deficiencies of *Omata et al.* and *Sasamoto et al.* by turning to *Faré*. *Faré* discusses an electrophotographic printing device having a drum 4 rotated by a motor 10 which is controlled by a control unit 12 in order to impart to the drum 4 a predetermined peripheral velocity. However, *Faré* does not disclose or suggest the feed-forward control and the feed-back control for controlling

the rotary speed as recited in claim 6. In addition, claim 6 recites the “control unit changes a speed control method for said driving unit according to the kind of image.” The speed control method may be based upon one of a variety of factors including, for example, a change from the feed-forward control to the feed-back control and vice versa (see Applicant’s specification at page 17, lines 20-22). It is respectfully submitted that *Faré* does not disclose or suggest changing the speed control method utilizing a speed control method based on feed-forward control and feed-back control as recited in claim 6.

In accordance with the M.P.E.P. § 2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 196 (CCPA 1970). Therefore, it is respectfully submitted that neither *Omata et al.*, *Sasamoto et al.* nor *Faré*, taken alone or in any proper combination, discloses or suggests the subject matter as recited in claim 6. Hence, withdrawal of the rejection is respectfully requested.

Claim 1 was allowed in the previous Office Action by the Examiner.

Claims 2-5 and 13-19 depend directly or indirectly from independent claim 1 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 1.

Claims 8-10 depend from independent claim 6 and are patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 6.

Claim 11 was allowed in the previous Office Action by the Examiner.

Claim 12 depends from independent claim 11 and is patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 11.

Claim 20 was allowed in the previous Office Action by the Examiner.

Claim 21 depends from independent claim 20 and is patentable over the cited prior art for at least the same reasons as set forth above with respect to claim 20.

In addition, each of these dependent claims also recite combinations that are separately patentable.

In view of the foregoing remarks, the claimed invention is not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this response, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, and drawings in this response, it is to be understood that Applicant in no way intends to limit the scope of the claims to any exemplary embodiments described in the specification and/or shown in the drawings. Rather, Applicant is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned patent agent at (202) 408-4328.

Please grant any extensions of time required to enter this response and charge  
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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